



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/814,461	03/21/2001	David Bodnick	BLZ-3	4114

1473 7590 05/08/2007
FISH & NEAVE IP GROUP
ROPES & GRAY LLP
1211 AVENUE OF THE AMERICAS
NEW YORK, NY 10036-8704

EXAMINER

GOTTSCHALK, MARTIN A

ART UNIT	PAPER NUMBER
----------	--------------

3694

MAIL DATE	DELIVERY MODE
-----------	---------------

05/08/2007

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/814,461

Applicant(s)

BODNICK, D

Examiner

Martin A. Gottschalk

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-48 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>10/30/2006</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Notice to Applicant

1. Claims 1-41 have been examined.

Election/Restrictions

2. This application contains claims 42-48 drawn to non-elected inventions. A complete reply to the final rejection must include cancellation of nonelected claims or other appropriate action (37 CFR 1.144) See MPEP § 821.01.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 14, 30-32, and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable Dorf (US Pat# 6,000,608, hereinafter Dorf) in view of Dawson et al (US Pat# 5,623,242, hereinafter Dawson).

A. As per claim 14, Dorf discloses a method for using a prepaid telecommunication access card to transmit medical compliance information (Dorf: abstract), the method comprising:

obtaining a prepaid telecommunication access card (Dorf: col 4, lns 14-25; Fig. 1; col 5, lns 27-29, obtaining reads on "...purchase...one of the cards...");

activating (Dorf: col 5, ln 49 to col 6, ln 7. This passage describes activation of the card) a medical compliance system with the prepaid telecommunication access card (Dorf: col 10, lns 7-47, this passage describes the card's use in a medical context; col 10 lns 16-20 describe how the card is used to activate the system. Note also col 10, 49-64, lns 49-52 in particular which disclose combining the functions of the prepaid phone card and the medical card.);

storing patient profile information accessible to the medical compliance system (Dorf: col 10, lns 10-13; Fig. 2, item 207);

Art Unit: 3694

transmitting at least one medical compliance message using the patient profile information (Dorf: col 10, Ins 22-26 describes the system sending a patient's medical history to a physician);

whereby:

a patient

obtains the prepaid telecommunication access card
(discussed as per the "obtaining" step above. The Examiner considers "...a customer..." to be read on by patient),

activates the medical compliance system with the prepaid telecommunication access card (discussed as per the "activating" step above. The Examiner considers patient to read on "authorized person.").

stores patient profile information accessible to the medical compliance system (Dorf: col 10, Ins 27-32, reads on "...medical history information may be updated by the patient..."), and

initiates the medical compliance system to transmit at least one message to the patient using the patient profile

(discussed as per the "activating" step above. The Examiner considers patient to read on "authorized person", and initiates to read on "...swiping the card...").

Dorf fails to explicitly disclose a medical compliance reminder system, which specifically transmits reminder messages to a patient to comply with a medical treatment regimen. However, this feature is well known in the art as evidenced by the teachings of Dawson. Dawson teaches a medical compliance reminder system which stores prescription information concerning a patient, and generates signals to devices to remind the patient to take a dose of prescribed medication (Dawson: abstract; Figs 1 and 2; col 2, lns 10-26).

It would have been obvious at the time of the invention to one of ordinary skill in the art to combine the teachings of reminding patients to comply with a medical regimen disclosed by Dawson with a prepaid smart card taught by Dorf with the motivation of providing a plurality of functions in one card, such as prepayment of services, billing for the services when they are used, and access to and retrieval of personal information, such as medical information associated with use of the services (Dorf, col 1, ln 10 to col 3, ln 6).

B. As per claim 30, Dorf discloses the method of claim 14, further comprising at least one of:

asking if the patient would like to discontinue the reminder phone calls;

asking if the patient would like another call after a specified time interval;

contacting the patient after a specified time interval to ask whether to discontinue the reminder phone calls;

asking whether to continue the reminders;

asking if the patient wants more time to determine whether to discontinue the calls;

asking for the time interval;

calling back at a specified time to present the discontinuation question again, and asking whether more time is needed to make that decision;

asking if the patient wants to discontinue use and registering an affirmative response to the database to cancel future reminders for this medicine;

asking if the patient wants to discontinue use and registering an affirmative response to the database to cancel future reminders for this medicine, and contacting the administrator to report this event;

transmitting a message if the patient has discontinued use of the medicine conveying the danger of not completing a prescription course unless on the advice of a doctor and suggesting that the patient contact a doctor, registering the transaction to a database, and canceling future reminders for this medicine;

transmitting a message if the patient has discontinued use of the medicine conveying the danger of not completing a prescription course unless on the advice of a doctor and suggesting that the patient contact a doctor, registering the transaction to a database, and canceling future reminders for this medicine, and contacting the administrator to report this event;

asking whether the patient would like to discuss their decision with a doctor; asking whether the patient would like the call to be bridged to a doctor; asking whether the patient wants to receive a callback at a different time to confirm that they have chosen to discontinue use of the medicine, and if affirmative, recording the time interval for the callback;

and

recording this transaction to the patient profile information database and scheduling the deferred reminder (Dorf: col 7, Ins 28-33, i.e. the activation step is recorded).

Insofar as Applicant recites, "at least one of", it is immaterial whether or not all limitations recited be taught by the Dorf reference.

C. As per claim 31, Dorf discloses the method of claim 14, where the prepaid telecommunication access card is activated by at least one of:

activating the card in the store (Dorf: col 5, Ins 49-65).

Insofar as Applicant recites, "at least one of", it is immaterial whether or not all limitations recited be taught by the Dorf reference.

D. As per claim 32, Dorf discloses the method of claim 14, further comprising a user option to add more reminders to the card, the method comprising at least one of:

charging the new reminders to a payment method already on file;

charging the new reminders to a new payment method (Dorf: col 5, lns 25-29. To "recharge" the card, the customer pays at the retailer. The Examiner considers the methods of payment to be the usual type, i.e. cash, credit or debit card, etc. The customer could choose from any of these to recharge a card, and could use a different – read on by on "new" – method of payment on different occasions. ;

transferring money from an account;

billing to the patient;

and

billing to a third party.

Insofar as Applicant recites, "at least one of", it is immaterial whether or not all limitations recited be taught by the Dorf reference.

E. As per claim 37, Dorf discloses the method of claim 14, further comprising

an auto-refill option that automatically adds additional reminders to the card when the card runs out of reminders (Dorf: col 9, lns 22-24. Note the disclosure of an auto re-fill, reads on "...when the card bearer reaches certain predefined point

Art Unit: 3694

plateaus...rewarded...with additional card value...". Note also Dorf: col 8, Ins 3-6, the disclosure of using Internet-based credit card payments. Rather than a point plateau, the card being out of reminders could be used to trigger the auto-refill which would be paid for via the Internet-based credit card method using stored credit card information).

6. Claims 15-25, 33-35, and 38-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dorf in view of Dawson as applied to claim 14 above, and further in view of Pilarczyk (US Pat# 4,766,542, hereinafter Pilarczyk).

A. As per claim 15, Dorf and Dawson fail to explicitly disclose the method of claim 14, further comprising:

asking whether the patient took the medicine; and
obtaining a patient acknowledgement response to the medical reminder message.

However, these features are well known in the art as evidenced by the teachings of Pilarczyk.

Pilarczyk discloses

asking (Pilarczyk: col 11, Ins 14-15) whether the patient took the medicine (Pilarczyk: col 11, Ins 4-6;); and

obtaining a patient acknowledgement response to the medical reminder message (Pilarczyk: col 7, Ins 47-53).

It would have been obvious to one of ordinary skill in the art at the time of the invention to extend the medical information component of the invention of Dorf by combining it with the teachings of Pilarczyk with the motivation of improving patient compliance with a prescribed drug regimen (Pilarczyk: col 1, Ins 30-40).

Note: It is to be understood that in the following paragraphs B through S, the Dorf and Dawson references do not teach the claimed material unless it is otherwise specified as it is in paragraph R for claim 40.

It is to be understood further that the motivation to combine the teachings of Dorf, Dawson, and Pilarczyk in all of the following paragraphs is the same as provided above for claim 15 and is incorporated herein.

B. As per claim 16, method of claim 14, further comprising:

obtaining the patient's name; obtaining patient contact information; and
storing the patient's name and contact information (Pilarczyk: col 3, Ins 40 50).

C. As per claim 17, Pilarczyk discloses the method of claim 14, further comprising
configuring patient profile information to include a number of medical compliance reminders to transmit (Pilarczyk: col 7, Ins 5-18. The Examiner notes that a single patient profile might include multiple prescriptions requiring multiple reminders).

D. As per claim 18, Pilarczyk the method of claim 14, further comprising

configuring the patient profile information to include a sequence of dates and times for each medical compliance reminder (Pilarczyk: col 7, lns 5-15. Note that each prescription in a patient profile contains at least a prescription refill due date, the date of the last refill, and the schedule on which the customer was told to take the drug. The Examiner considers these to be a sequence of times and dates).

E. As per claim 19, Pilarczyk discloses the method of claim 14, further comprising combining multiple message transmissions for multiple medicines so that one reminder message is transmitted if two or more medicines can be taken simultaneously (Pilarczyk: col 8, ln 61 to col 9, ln 2. Note that the pharmacist can single out certain customers for special treatment such as a personal phone call. Should a patient need to refill multiple medicines, rather than choosing to bother the patient with multiple automated calls, the pharmacist can elect to call the patient personally so that the refill reminder for all of the multiple medicines can be done in one phone call.).

F. As per claim 20, Pilarczyk discloses the method of claim 14, further comprising at least one of:

- obtaining a language selection; obtaining a sequence of patient contacts to try until a response is received indicating the presence of the patient;

- obtaining a sequence of patient contacts to try until a response is received indicating an answering machine;

- obtaining a list of at least one patient contact point;

obtaining at least one alternate patient contact sequence for different days of the week, times of day, special days, and combinations thereof;

obtaining at least one different patient profile preference for different days of the week, times of day;

special days, and combinations thereof;

obtaining at least one custom message from the patient;

obtaining at least one custom message from a third party;

selecting at least one custom message from a list of prerecorded voices;

obtaining selection information indicating whether usage instructions should be transmitted with some or all of the reminders;

obtaining selection information indicating instructions to be transmitted as to the use of the medicine;

obtaining selection information indicating instructions to be read as to how the patient should handle missed doses;

obtaining selection information indicating whether an answering machine message should be left;

obtaining a selection indicating whether the system should ask for the patient before asking whether the patient has taken the medicine;

obtaining a selection indicating whether to wait for the patient to take the medicine before hanging up;

obtaining a selection indicating whether to remind the customer to order a refill when the medicine is running out;

obtaining a selection indicating whether the patient should be asked about specific side effects;

obtaining a selection indicating whether to contact an administrator in situations when a patient cannot be reached;

obtaining a selection indicating whether to contact an administrator in situations when a patient has discontinued the medication;

obtaining a selection indicating whether to contact an administrator in situations when a patient needs a prescription refill (Pilarczyk: col 7, Ins. The Examiner considers the pharmacy to be a form of administrator, and the message to be a selection indicating whether to contact the pharmacy.); and

obtaining a selection indicating whether to contact an administrator in situations when a patient needs to add more money to the prepaid reminder account.

G. As per claim 21, Pilarczyk discloses the method of claim 14, further comprising generating and transmitting confirmation of patient reminder profile configuration information (Pilarczyk: col 7, Ins 19-27).

H. As per claim 22, Pilarczyk discloses the method of claim 14, further comprising at least one of:

obtaining at least one administrator phone number (Pilarczyk: col 9, Ins 55-57.

The Examiner considers the pharmacy to be a form of administrator);

obtaining at least one administrator beeper contact number;

obtaining at least one administrator PDA contact address;

obtaining at least one administrator Instant Message account;

obtaining at least one administrator email address; and

obtaining at least one administrator fax number.

I. As per claim 23, Pilarczyk discloses the method of claim 14, further comprising generating a report summarizing patient reminders and responses (Pilarczyk: col 10, Ins 28-43).

J. As per claim 24, Pilarczyk discloses the method of claim 14, further comprising interaction scenarios comprising at least one of:

leaving a message if the patient cannot be reached;

generating a message that asks the patient to press a specified key at the phone (Pilarczyk: col 7, Ins 47-51);

generating a message that asks the patient to come to the phone and say a specified phrase;

generating a message that asks the patient to come to the phone and press a specified key, and if the patient is not there asking the person who answers to press a key;

generating a message that asks the patient to come to the phone and say a specified phrase, and if the patient is not there asking the person who answers to say a specified phrase;

splicing a recording of the patient's name the message at the points where the name should be read;

trying the next patient contact number when an answering machine picks up and the patient has specified that other contact methods should be tried;

trying the next contact method when the person who responds indicates that the patient is not there;

waiting a preset interval and then trying again, and giving up after a number of unsuccessful attempts;

contacting the administrator, doctor, relative, or other third party to notify them that the patient could not be reached; and

contacting an administrator, doctor, relative, or other third party when the patient is unreachable for a few consecutive reminders.

K. As per claim 25, Pilarczyk discloses the method of claim 14, further comprising playing a name of the patient's medicine from at least one of:

(a) a recording that an administrator had made with text-to-speech of the medicine name (Pilarczyk: col 8, Ins 11-15. Note also Fig. 2, item 46, and Fig. 3, items 104-106. The speech synthesizer converts text to speech from information obtained from the schedule file, which includes information entered by pharmacy personnel which the Examiner considers to be a form of administrator.), and

(b) a pre-recorded message that corresponds with the medicine name, where the pre-recorded message is selected from a plurality of pre-recorded messages for a number of common medicines.

L. As per claim 27, Pilarczyk discloses the method of claim 14, further comprising a user interaction scenario comprising:

asking if the patient wants to be reminded again in an unspecified interval; and

asking for input regarding when to try back marking a deferred transaction in response thereto to a database and repeating the reminder at the specified time (Pilarczyk: col 7, ln 65 to col 8, ln 27).

M. As per claim 33, Pilarczyk discloses the method of claim 14, further comprising at least one of:

transmitting a refill message if a refillable prescription is about to expire (Pilarczyk: col 7, Ins 33-35);

offering to connect the patient directly to a pharmacy to refill a prescription if a refillable prescription is about to expire; and

requesting the pharmacy to automatically refill the prescription if a refillable prescription is about to expire.

N. As per claim 34, Pilarczyk discloses the method of claim 14, further comprising offering a health tip, with an option to learn more by pressing a key on a phone (Pilarczyk: col 11, lns 15-20. The Examiner considers being reminded of a refill to be a form of health tip, and subsequently being provided the option to have the pharmacist call by pushing a button is a form of indicating a desire to learn more.).

O. As per claim 35, Pilarczyk discloses the method of claim 14, further comprising transmitting a sponsorship message, with an option to learn more by pressing a key on a phone (Pilarczyk: col 7, lns 48-51; col 9, lns 52-57. The Examiner considers the pharmacy to be a form of sponsor, thus it is respectfully submitted that the refill reminder is a sponsorship message.).

P. As per claim 38, Pilarczyk discloses the method of claim 14, further comprising at least one of:

obtaining at least a partial payment from a sponsor who has prerecorded a message;

Art Unit: 3694

obtaining at least a partial payment from a sponsor who has a prerecorded message in which the user can press a key or keys to hear more information from the sponsor;

obtaining at least a partial payment from medical insurance;

obtaining at least a partial payment from a medical insurance company;

providing a message reminding the person to refill their prescription (Pilarczyk: col 9, lns 50-57);

providing a message reminding the person to refill their prescription and connecting the patient directly to the pharmacy at which the prepaid reminders were purchased;

providing a message reminding the person to refill their prescription and connecting the patient to the sponsoring pharmacy;

providing a message reminding the person to refill their prescription, and connecting the patient to the sponsoring pharmacy with a promotional fee paid by the pharmacy;

charging per reminder;

charging per minute; and

charging per prescription.

Q. As per claim 39, Pilarczyk discloses the method of claim 14, further comprising

commercial alternatives for marketing the prepaid telecommunications access card comprising at least one of:

- marketing the prepaid telecommunication card to a pharmacy (Pilarczyk: col 7, lns 35-39, reads on "retail issuer");

- marketing the prepaid telecommunication card to a doctor;

- marketing the prepaid telecommunication card to a doctor who recommends use of the card to a patient;

- marketing the prepaid telecommunication card to a health care professional;

- marketing the prepaid telecommunication card to a pharmaceutical distributor;

and

- marketing the prepaid telecommunication card to a pharmaceutical company.

R. As per claim 40, Dorf discloses the method of claim 14, further comprising a method of identifying the patient comprising at least one of:

- requesting a security confirmation to verify whether the person seeking to receive a reminder information is actually the patient by asking for a secret piece of information (Dorf suggests the use of PIN numbers, as well as entering the card number over the phone; see Dorf: col 10, lns 18-20 for PIN numbers, and col 10 lns 37-39 for entering the card number.).

However, Dorf fails to explicitly disclose making the request of the person who picks up the phone.

However, this feature is well known in the art as evidenced by Pilarczyk who teaches using the touchtone phone to provide confirmations and acknowledgements (Pilarczyk: col 8, lns 16-19).

S. As per claim 41, Pilarczyk discloses the system of claim 14, wherein the transmitting of the medical reminder message includes

transmitting a query message that inquires whether the patient is ok (Pilarczyk: col 9, lns 28-41. The Examiner considers affirmatively responding to the query "...if you have answered the phone..." by pressing a phone key to be an indication the recipient of the message is ok. Since the number dialed is that of a patient, it is respectfully submitted that the message is a form of inquiry as to whether the patient is ok.).

7. Claim 26 rejected under 35 U.S.C. 103(a) as being unpatentable over Dorf in view of Dawson as applied to claim 14 above, and further in view of Reber et al (US Pat# 5,950,632, hereinafter Reber).

A. As per claim 26, Dorf and Dawson fail to disclose the method of claim 14, further comprising:

prompting to the patient to press a first key on the telephone when their medicine has been taken;

prompting to the patient to press a second key on the telephone when to be reminded again after a predetermined time;

prompting to the patient to press a third key on the telephone when to be reminded again at a different time;

prompting to the patient to press a fourth key on the telephone if there are concerns about taking the medicine;

prompting to the patient to press a fifth key on the telephone if they have discontinued the use of the medicine;

transmitting a congratulatory message if the patient indicates the medicine has been taken; and

recording the transaction to a database.

However, these features are well known in the art as evidenced by the teachings of Reber.

As per the steps of

prompting to the patient to press a first key on the telephone when their medicine has been taken;

recording the transaction to a database,

Reber discloses a method that includes a medical communication apparatus associated with a user (i.e. patient) with an input device that includes "any plurality" of buttons (Reber col 8, Ins 50-54). Reber also discloses that signals can be sent from the medical communication apparatus to another communication unit associated with the user such as a telephone (Reber: col 3, Ins 9-18), and the Examiner respectfully submits that all of the processes to be described could be accomplished over the telephone.

Reber teaches a signal being sent from a medical database to the medical communication apparatus prompting the user to take a medication (Reber col 10, Ins 5-9; Fig. 6). After taking the medication, the user depresses a first button to indicate compliance (Reber: col 8, Ins 55-56). This message (which the Examiner considers to be a form of congratulatory message) is sent to the medical database and recorded in a compliance history record (Reber: col 10, Ins 20-23; Fig. 6, item 214).

As per the steps of

prompting to the patient to press a second key on the telephone when to be reminded again after a predetermined time;

prompting to the patient to press a third key on the telephone when to be reminded again at a different time;

the medical database taught by Reber contains information regarding the times to take medicine(s) which is communicated to the medical communication apparatus (Reber col 2, Ins 50-65). If multiple medications are to be taken (e.g. three medicines), after taking the first medicine, the user presses a first key to confirm compliance that the first medicine has been taken. The system thus knows not to take further action regarding this particular dose of the first medicine as would be the case for non-compliance, and will move on to reminding the user regarding the time to take the next medicine, which will come after a predetermined time set by the prescribed regimen. When the next medicine is to be taken, the previous steps are taken, and the user presses a second key to indicate compliance. The process would be repeated for the final medicine

followed by the pressing of a third key, the cycle is repeated, and the user will be reminded again at a different time.

As per the steps of
prompting to the patient to press a fourth key on the telephone if there are concerns about taking the medicine;

prompting to the patient to press a fifth key on the telephone if they have discontinued the use of the medicine;

Reber discloses a method whereby a medicine container can sense whether it is out or low on medicine, and a refill is in order (Reber, col 11, ln 54- col 12, ln 35). The container sends a signal in this regard to the medical communication apparatus (Reber: col 6, lns 14-15). Further, by communicating this message to a pharmacy, the pharmacy can refill the prescription (Reber: col 13, 60-63). As previously mentioned, the medical communications apparatus uses key presses to send communications, thus the patient could forward a refill request to the pharmacy by pressing a key. If pressing a key to refill the medicine was prompted by the medicine being completely out, this information would be sent to the pharmacy as well (Reber: col 12, lns 30-35), and it is respectfully submitted that the refill request would be an indication that the medication had been discontinued. In addition, the Examiner considers that needing to order a medicine refill is a form of concern about taking the medicine (i.e. the patient is concerned because the medicine is out or running low).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Reber within the combined teachings of Dorf

Art Unit: 3694

and Dawson with the motivation of avoiding the difficulties associated with a multiple medication regimen including the avoidance of harmful drug interactions (Reber: col 1, Ins 34-38 and 55-61).

B. As per claim 29, Dorf and Dawson fail to disclose the method of claim 28, further comprising

contacting an

administrator,

pharmacy,

pharmaceutical company, or

doctor

to alert them to a potential side effect.

However, these features are well known in the art as evidenced by the teachings of Reber.

Reber discloses a system whereby in response to the application of a data reader to a medicine container, an associated medical communications apparatus can download information about the medicine to the patient, including warnings about side effects (Reber, col 13, Ins 7-12). Reber further teaches contacting a caregiver via a plurality of methods including paging, telephone, or e-mail (Reber: col 10, Ins 40-50).

The motivation to combine the teachings of Dorf, Dawson, and Reber are as provided above for claim 26 and are incorporated herein.

C. As per claim 36, Dorf and Dawson fail to disclose the method of claim 14, further comprising:

checking for harmful drug interactions; and
sending a warning to the patient if a potentially harmful drug interaction is detected.

However, these features are well known in the art as evidenced by the teachings of Reber.

Reber discloses a system whereby in response to the application of a data reader to a medicine container, an associated medical communications apparatus can download information about the medicine to the patient, including warnings about interactions with other medicines (Reber, col 13, Ins 7-12).

The motivation to combine the teachings of Dorf, Dawson, and Reber are as provided above for claim 26 and are incorporated herein.

8. Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Dorf in view of Dawson as applied to claim 14 above, and further in view of Pilarczyk and Reber.

A. As per claim 28, Pilarczyk discloses the method of claim 14, further comprising asking questions if the patient has concerns about taking the medicine (Pilarczyk: col 9, Ins 34-60. The Examiner considers asking questions about refilling a prescription

Art Unit: 3694

to be a form of asking if the patient has concerns about taking the medicine, i.e. is the patient concerned that the medicine is out or running low); and

taking at least one of the following actions:

discontinuing use of the medicine immediately,

contacting a

physician or

pharmacist immediately for further instructions (Pilarczyk: col 11,

15-19. The Examiner considers that to "...push another number,"

to get the pharmacist to call back is a form of contacting the

pharmacist immediately.),

contacting a poison control center, hospital, emergency center, doctor for further instructions.

Pilarczyk fails to disclose

the questions comprising:

asking if the patient would like to hear a list of potential side effects, and if so, transmitting a list of the potential side effects and possible remedies therefor;

asking if the patient believes they may have at least one symptom,

and if so, advising the patient to

However, these features are well known as evidenced by the teachings of Reber.

Reber teaches in response to reading information encoded on a medicine container, downloading information including side effects and interactions of the

medicine. The Examiner considers a side effect to be a type of symptom (Reber: col 13, Ins 7-12).

Pilarczyk further fails to disclose

bridging the call directly to a poison control center, hospital, emergency center, or doctor, with a subset of the patient profile information.

However, Reber teaches contacting (read on by bridging the call) a caregiver (read on by doctor) if no message confirming compliance with a medication regimen is received via the medical communication apparatus (Reber: col 10, Ins 40-50).

It would have been obvious to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Reber within the method of Pilarczyk with the motivation of avoiding the difficulties associated with a multiple medication regimen including the avoidance of harmful drug interactions (Reber: col 1, Ins 34-38 and 55-61).

9. As per claims 1-13 they are system claims which repeat the same limitations of claims 14-41 the corresponding method claims, as a collection of elements as opposed to a series of process steps. Since the teachings of the cited references disclose the underlying process steps that constitute the methods of claims 14-41 it is respectfully submitted that they provide the underlying structural elements that perform the steps as well. As such, the limitations of claims 1-13 are rejected for the same reasons given above for claims 14-41.

The particular correspondences are as follows:

Claim 1 corresponds to claim 14.

Claim 2 corresponds to claim 16.

Claim 3 corresponds to claim 17.

Claim 4 corresponds to claim 18.

Claim 5 corresponds to claim 19.

Claim 6 corresponds to claim 31.

Claim 7 corresponds to claim 31.

Claim 8 corresponds to claim 24.

Claim 9 corresponds to claim 40.

Claim 10 corresponds to claim 21.

Claim 11 corresponds to claim 20.

Claim 12 corresponds to claim 22.

Claim 13 corresponds to claim 23.

Response to Arguments

10. Applicant's arguments with respect to claims 1-41 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

11. Applicant's submission of an information disclosure statement under 37 CFR 1.97(c) with the fee set forth in 37 CFR 1.17(p) on 10/30/2006 prompted the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 609.04(b). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).


A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Martin A. Gottschalk whose telephone number is (571) 272-7030. The examiner can normally be reached on Mon - Fri 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P. Trammell can be reached on (571) 272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


MG
04/02/2007


J. P. TRAMMELL
ADVISORY PATENT EXAMINER
TECHNOLOGY CENTER